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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,911	06/26/2001	Daniel R. Johnson	3034.1000-001	1408

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EXAMINER

BASHORE, ALAIN L

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,911

Applicant(s)

JOHNSON ET AL.

Examiner

Alain L. Bashore

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4.5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 13, 20-38, 46, 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following recitations are deemed vague and indefinite:

“features”

“suitability”.

Claims 20-38 recite “system” which is vague and indefinite since a system may be one of several different statutory classes of invention (including a method or an apparatus). Applicant must indicate on the record what statutory class of invention the system claims belong to. For the purposes of this examination these claims are considered method.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-19 are rejected under 35 U.S.C. 101 as non-statutory. The method claims as presented do not claim a technological basis in the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim at least one structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) – used only for content and reasoning since not precedential].

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-8, 18-20, 22-27, 37-39, 41-45, 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al.

Robinson et al discloses a method for comparing financial products. There is selected two or more financial products for comparison of a set of attributes (col 1, lines 45-61). Each financial product having values corresponding to the set of attributes and there is assigned a weight to each of the attributes (col 6, lines 1-28). There is scaling the values of the financial products across each attribute, multiplying the scaled values by the assigned weights, and generating a weighted score for each financial product by summing the weighted scaled values for each product (col 1, lines 66-67; col 2, lines 1-9). The two or more financial products compared include mutual funds (col 2, lines 54-55). Assigned weights are used and subjective scores from a user are also used.

Maximum and minimum values are identified and adjusted values and range are made (col 6, lines 28-51). Grades from one or more financial databases where the databases provides a comparative grade of financial strength of financial product carriers is disclosed (col 8, lines 50-61).

Robinson et al does not expressly show the steps as funding sources for a financial plan.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowery*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art to include the steps as funding sources for a financial plan, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentability distinguish the claimed invention.

5. Claims 2, 21, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al as applied to claims 1, 3-8, 18-20, 22-27, 37-39, 41-45, 55-56 above, and further in view of Bi et al.

Robinson et al does not disclose changing the assigned weight for at least one of the attributes to compare financial tradeoffs.

Bi et al discloses changing the assigned weight for at least one of the attributes to compare financial tradeoffs (fig 11).

It would have been obvious to one with ordinary skill in the art to include changing the assigned weight for at least one of the attributes to compare financial tradeoffs because Bi et al discloses flexibility in making financial decisions (col 2, lines 22-29).

6. Claims 9-10, 15-16, 28-29, 34-35, 46-47, 52-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al as applied to claims 1, 3-8, 18-20, 22-27, 37-39, 41-45, 55-56 above, and further in view of Powers et al.

Robinson et al does not disclose contractual features, products are compared for individual financial panning, or are compared which include life insurance policies.

Powers et al discloses contractual features of life insurance policies (col 2, lines 9-23), products compared for individual financial panning (col 4, lines 1-6),

It would have been obvious to one with ordinary skill in the art to include contractual features or comparing life insurance policies powers et al teaches financial products include life insurance policies and their contractual features (col 4, lines 1-6).

It would have been obvious to one with ordinary skill in the art to include products compared for individual financial planning because such is disclosed by Powers et al as part of financial analysis.

7. Claims 11, 17, 30, 36, 48, 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Powers et al as applied to claim 9 above, and further in view of Ryan et al.

Robinson et al does not disclose cash flow with discounted value, internal rate of return, after tax considerations. Robinson et al also does not disclose corporate-owned life insurance policies.

Ryan et al discloses cash flow with discounted value, internal rate of return, after tax considerations and corporate-owned life insurance policies (col 14, lines 9-55).

It would have been obvious to one with ordinary skill in the art to include cash flow with discounted value, internal rate of return, after tax considerations and corporate-owned life insurance policies because Ryan et al discloses required calculation for a type of financial policy.

8. Claims 12, 31, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Powers et al as applied to claim 9 above, and further in view of Tyler et al.

Robinson discloses ratings and Powers discloses mortality charge and expense charge guarantees.

Robinson et al in view of Powers does not disclose de-MECing provisions.

Tyler et al discloses de-MECing provisions (col 45, lines 40-49).

It would have been obvious to one with ordinary skill in the art to include de-MECing provisions because Tyler et al teaches such as desired in the financial art (col 45, lines 40-49).

9. Claims 13, 32, 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Powers et al as applied to claim 9 above, and further in view of De Tore et al.

Robinson et al does not disclose suitability of underwriting offer.

De Tore et al discloses suitability of underwriting offer (col 10, lines 55-67; col 11, lines 1-3).

It would have been obvious to one with ordinary skill in the art to include suitability of underwriting offer because De Tore et al teaches that underwriting requires consideration of suitability such as classification that is taught by Det Tore et al.

10. Claims 14, 33, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al as applied to claims 1, 3-8, 18-20, 22-27, 37-39, 41-45, 55-56 above, and further in view of Davis.

Robinson et al does not disclose selecting a non-qualified supplemental benefits plan, the two or more financial products compared for funding the plan.

Davis discloses selecting a non-qualified supplemental benefits plan, the two or more financial products compared for funding the plan (para 0031).

It would have been obvious to one with ordinary skill in the art to include selecting a non-qualified supplemental benefits plan, the two or more financial products compared for funding the plan because Davis teaches such as a type of financial product.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:00 am to 4:30 pm (Monday thru Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Alain L. Bashore